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SEP 18 2002

OFFICE OF PETITIONS

In re Application of :
Amit, Thomson, and Itskovitz-Eldor :
Application No. 09/975,011 :
Filed: 12 October, 2001 :
Attorney Docket No. 01/22631 :
ON PETITION

This is in response to the correspondence filed on 14 May, 2002, which is being treated as a petition under 37 CFR 1.48(a) and 1.47(a).

The petition under 37 CFR 1.48 is **DISMISSED**.

The petition under 37 CFR 1.47 is **DISMISSED**.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.48(a) and 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

On 12 October, 2001, the present application was filed without an executed oath or declaration.

Accordingly, on 14 November, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring the statutory basic filing fee, additional

claim fee(s), a signed oath or declaration, and a surcharge for its late filing.

In response, on 11 April, 2002, petitioners filed authorization to charge counsel's deposit account for the basic filing fee, additional claim fee(s), the late filing surcharge, and a three (3) month extension of time fee, as well as a declaration naming Michel Amit, James A. Thomson, and Joseph Itskovitz-Eldor as joint inventors and signed by joint inventors Amit and Itskovitz-Eldor on behalf of themselves and joint inventor Thomson.

Accordingly, on 16 May, 2002, Initial Patent Examination Division mailed a Notice of Incomplete Reply (Nonprovisional) requiring the signature of joint inventor Thomson on the declaration. This Notice was preceded by the filing, however, on 14 May, 2002, of the present petition under 37 CFR 1.48(a) to delete joint inventor Itskovitz-Eldor as a joint inventor as well as a petition under 37 CFR 1.47(a) stating that joint inventor Thomson has refused to sign the declaration.

Petition Under 37 CFR 1.48(a)

A grantable petition under 37 CFR 1.48(a) requires:

- (1) a petition including a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43, or 1.47;
- (3) the fee set forth in 37 CFR 1.17(I); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR 3.73(b)).

The present petition lacks items (1) and (4). In this regard, it is noted that the person sought to be deleted as inventor is named on the declaration, and signed the declaration as "Joseph Itskovitz-Eldor", while the statement of lack of deceptive intent names, and is signed by, the person sought to be deleted as an inventor as "Joseph Itskovitz". As such, it is not clear that the statement of lack of deceptive intent was signed by an individual named on the declaration filed on 11 April, 2001. The name of the individual signing the statement of lack of deceptive intent must be the same as the name of the person listed on the

oath or declaration sought to be deleted as an inventor. Likewise, the consent of the assignee, Technion Research and Development Foundation Ltd., signed by Avishai Tzur, lists the name of the person to be deleted as an inventor as "Joseph Itskovitz". The name of the person to be deleted as an inventor as named by the consent of the assignee must match the name of the person listed on the original oath or declaration.

Petition Under 37 CFR 1.47(a)

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), it is unclear what inventive entity was listed on the declaration sent with the application papers to non-signing joint inventor Thomson. If the declaration sent to Thomson listed Itskovitz-Eldor as a joint inventor, then it cannot be ruled out that Thomson refused to sign the declaration due to inventorship *per se*. If that is the case, petitioners should send an additional copy of the application papers, accompanied by a declaration naming the proper inventive entity (Amit and Thomson). Any renewed petition should state whether the declaration listing Amit, Thomson, and Itskovitz-Eldor or Amit and Thomson as joint inventors was sent with the application papers to joint inventor Thomson.

Likewise, if the declaration sent with the application papers to Thomson listed only Amit and Thomson as joint inventors, the petition must be dismissed because the oath or declaration which petitioners seek to have accepted under 37 CFR 1.47(a) as signed by joint inventor Amit on behalf of himself and joint inventor Thomson does not state the correct inventive entity in light of the dismissal of the petition under 37 CFR 1.48(a), as the

inventive entity is currently Amit, Thomson, and Itskovitz-Eldor. Petitioners should note, however, that if the declaration sent with the application papers to joint inventor Thomson lists the correct inventive entity (Amit and Thomson) the petition under 37 CFR 1.47(a) appears grantable pending submission of a grantable petition under 37 CFR 1.48(a).

Counsel's deposit account, No. 50-1407, will be charged \$260.00 for consideration of the petitions under 37 CFR 1.47(a) and 1.48(a). Additionally, counsel's deposit account will be charged the difference between a three (3) and four (4) month extension of the time to reply to the Notice to File Missing Parts mailed on 14 November, 2001 (\$260.00).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries concerning this matter may be directed to the undersigned at 703.308.6918.


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